

REMARKS

In the outstanding *Final Rejection*, all claims were rejected only on the basis of obviousness. The *Declaration* filed in this application earlier showing unexpected and surprising results has been made of record but deemed insufficient.

Reconsideration of that conclusion in view of the following remarks is respectfully requested.

As was noted in *In re Soni*, 34 USPQ2d 1684, 1687 and following (CAFC 1995), Declaration evidence of unexpected results ordinarily suffices for purposes of nonobviousness:

Mere improvement in properties does not always suffice to show unexpected results. In our view, however, when an applicant demonstrates substantially improved results, as Soni did here, and states that the results were unexpected, this should suffice to establish unexpected results in the absence of evidence to the contrary. Soni, who owed the PTO a duty of candor, made such a showing here. The PTO has not provided any persuasive basis to question Soni's comparative data and assertion that the demonstrated results were unexpected. Thus, we are persuaded that the Board's finding that Soni did not establish unexpected results is clearly erroneous.

The cases cited by the dissent are not to the contrary. Neither De Blauwe, nor Wood, nor Lindner requires a showing of unexpectedness separate from a showing of significant differences in result. Nor does Merck, which involved compositions understood to differ only in "a matter of degree." Those are not the facts here, where substantially improved properties were shown. Given a presumption of similar properties for similar compositions, substantially improved properties are *ipso facto* unexpected. The difficulty postulated by the dissent in distinguishing substantial from insubstantial improvement is no greater than the PTO and the courts have encountered, successfully, for many years in making judgments on the question of obviousness. It is not unworkable; it is simply the stuff of adjudication. Nor does it change established burdens of proof. The PTO here established a *prima facie* case, the applicant responded to it with a showing of data, and the PTO made an inadequate challenge to the adequacy of that showing.

In this application, Galyn Schulz, a highly experienced individual has stated in his *Declaration* filed in June, 2002 that the claimed process was surprisingly robust with respect to contaminants; *note* paragraphs 5-8 of the June, 2002 *Declaration*:

5. That he has personally observed the operation of an embossing station such as described in Claim 1 above; that is, a roll having a Shore A hardness of greater than 90 was matched with an engraved rubber roll having a Shore A hardness of between 40 and 65, and the rolls were biased against each other and used to emboss paper sheet. More specifically, a female sleeve was engraved on a sleeve of Shore A 100 hardness and matched with a male roll made with a sleeve of a soft rubber material having a Shore A hardness of 60.
6. That during such operation, various objects were purposely fed to the embossing nip to test its ability to pass contaminants without damage to the embossing station, including such objects as paper clips and coins.
7. That such objects fed to a conventional embossing nip would cause extensive damage to matched embossing rolls, a steel/steel matched set, for example; however, it was surprisingly found that neither paper clips nor coins damaged the embossing rollers when the method of the invention of the above-noted patent application was employed. Following is an excerpt from a research report detailing operation of the method of the invention of the above-noted patent application:

As part of the trial items such as a paper clip, a dime, and wadded paper were passed through the nip of the 100/60 durometer sleeves. The items were taped to the emboss roll and ran through the emboss nip five times. The emboss sleeves were examined with a 40X microscope and no damage could be detected on either the 100 durometer female sleeve or the 60 durometer male sleeve. The emboss gap was set at 26 mils which was the emboss gap required to achieve the targeted 1-ply tissue attributes. Also during the set up of the 100/60 durometer emboss sleeves there were some set up errors made, which results in the rolls being run mismatched at a supposed 0.010" emboss gap. Neither the 100 durometer female sleeve nor the 60 durometer male sleeve was damaged.

8. That despite his more than twenty-five (25) years of experience with embossing, he found it surprising that the method of the invention could be employed to withstand contaminants such as coins fed to the nip without damage to the embossing rollers. Such damage is difficult (as well as expensive) to repair and leads to significant down time of expensive machinery.

The references cited, *Schulz* '983 and *Grupe* '617 contain no disclosure to rebut the showing of unexpected results; and accordingly, all claims should be allowed.

With respect to new Claims 17, 18 and 19 which require "stickies" in the web processed, there is not even a remote suggestion in the references that the claimed embossing process would be useful in resisting damage due to accumulated stickies.

The Examiner has acknowledged that neither *Schulz* nor *Grupe* contain any disclosure relating to contaminants or recycled paper as claimed. The conclusion that the claimed process is *prima facie* obvious in view of the deficiencies of the references is accordingly traversed. The conclusion that the *Declaration* is insufficient is untenable under *Soni*.

This response is being filed with a *Petition* and fee for a two-month *Extension of Time*. If any additional extensions are required, please consider this a *Petition* therefore and charge our Deposit Account No. 50-0935.

If for any reason the Examiner would like to discuss this application, the Examiner is invited to call at the number listed below.

Respectfully submitted,



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